

U.S. Patent Application No. 09/900,684
Attorney Docket No. 13DV13928 (07783-0076)

REMARKS

The Office Action mailed November 1, 2004 has been received and carefully considered. Claims 1-20 are currently pending. Claims 1-8, 10, 12-16, 18 and 20 stand rejected under 35 U.S.C. §102(c) as anticipated by U.S. Publication 2003/0140315 to Blumberg, et al. (Blumberg). Claims 9 and 17 stand rejected under 35 U.S.C. §103(a) as unpatentable over Blumberg in view of U.S. Patent 6,462,756 to Hansen, et al. (Hansen). Claim 11 stands rejected under 35 U.S.C. §103(a) as unpatentable over Blumberg in view of www.kinkos.com as archived February 24, 2001 at www.archive.org (www.kinkos.com) and further in view of a Business Wire article dated November 10, 1999 entitled "Internet Printing Solution Digitally Enables Printing Service Bureaus: New Digital Solutions Offer Print Providers 'Tremendous Opportunities' (Internet Printing Solutions). Claim 19 stands rejected under 35 U.S.C. §103(a) as unpatentable over Blumberg in view of www.kinkos.com.

I. Administrative matters.

In the Office Action, at number 12 of the Office Action summary, the Examiner acknowledged a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). Applicants respectfully note that no claim for foreign priority was made in the subject Application and that box 12 of the Office Action summary was apparently checked by the Examiner in error.

Further, the Examiner did not return, nor does the Office Action summary reflect that the Examiner returned, the Form PTO-1449 submitted by Applicants as part of an Information Disclosure Statement on December 7, 2001 listing 8 references for consideration by the Examiner. Although an initialed copy of the form was not returned to Applicants, the image file wrapper for the Application available on the Patent Application Information Retrieval system

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indicates that the IDS was in fact received and that the Examiner actually considered the references provided by Applicants.

Applicants respectfully request that the Examiner clarify these points in the next official communication regarding the Application and Applicants further request the Examiner return to Applicants an initialed copy of the Form PTO-1449 for Applicants' records evidencing the references submitted were considered by the Examiner.

II. Rejection under 35 U.S.C. § 102(e).

Claims 1-8, 10, 12-16, 18 and 20, of which claims 1, 12 and 18 are independent, stand rejected as anticipated by Blumberg. Applicants respectfully traverse the rejection. Specifically, Blumberg is said to disclose an online print on-demand service system connected to the internet or an intranet that includes an electronic document management system, a user interface and a service provider production interface. Office Action at pages 2-3.

Claim 1 is directed to a system for submitting and monitoring copy reproduction order requests. The system comprises a database to store information on copy reproduction requests, wherein the stored information comprises order information on copy reproduction requests and status information on copy reproduction requests; a first client computer communicating with the database, wherein the first client computer being accessible by a user; a second client computer communicating with the database to access the stored information on copy reproduction requests in the database, wherein the second client computer being accessible by a copy reproduction service provider; and an application for submitting and monitoring copy reproduction requests accessible on the first client computer by a user. The application comprises means for entering order information on a copy reproduction request by a user; means for storing the entered order

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information on a copy reproduction request in the database; and means for retrieving status information from the database on a copy reproduction request submitted by a user.

Blumberg is directed to a method of creating and viewing content to be printed, including receiving an electronic document, selecting finishing options for the document and displaying how the electronic document would look as a finished document. Blumberg at Abstract. Blumberg further describes an online print-on demand service that sends jobs to print production centers. Blumberg at [0034].

Applicants' claimed invention requires a database to store information on copy reproduction requests, which information includes order information and status information. Applicants' claimed invention further requires a first and second client computer in communication with the database.

Blumberg fails to teach a database that stores information on copy reproduction requests, much less one that stores both order information and status information. The only databases taught by Blumberg are separate inventory and pricing databases (Blumberg at [0122]-[0129]) to store information on available printing materials and prices of jobs respectively, as well as a customer account database (Blumberg at [0151]) to information on personal and corporate accounts, and a document database. Blumberg at [0157]. Thus, not only does Blumberg fail to teach a database that stores information on copy reproduction requests, those databases that Blumberg does teach fail to consolidate information, such as the database to store information on copy reproduction requests as found in Applicants' claimed invention.

Applicants' database stores information on copy reproduction requests including order information and status information. Copy reproduction requests, corresponding files and

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associated information are stored as binary large objects that can later be accessed by the service provider.

As Blumberg fails to teach a database as found in Applicants' claimed invention, Blumberg also necessarily fails to teach a first and second client computer in communication with the database or an application that includes means for storing information on, or retrieving information from, the database.

Independent claims 12 and 18 also contain the relevant limitations discussed with respect to claim 1 above. Because claims 12 and 18 stand rejected for the same rationale as claim 1, claims 12 and 18 are not anticipated by Blumberg for at least the reasons provided above. *A fortiori*, all claims depending from claims 1, 12 or 18 are also not anticipated by Blumberg, and the rejection of claims 1-8, 10, 12-16, 18 and 20 should be withdrawn.

III. Rejection under 35 U.S.C. § 103(a).

As stated by the Federal Circuit, "a proper analysis under 35 U.S.C. § 103 requires, *inter alia*, consideration of two factors: (1) whether the prior art would have suggested to those of ordinary skill in the art that they should make the claimed composition or device, or carry out the claimed process; and (2) whether the prior art would also have revealed that in so making or carrying out, those of ordinary skill would have a reasonable expectation of success." *In re Vaeck*, 947, F.2d 488, 493 (Fed. Cir. 1991). In addition, the prior art reference(s) must teach or suggest all of the claim limitations. The teaching or suggestion to combine and the reasonable expectation of success must both be found in the prior art, and not in Applicant's disclosure. *Id* at 493. *See also* M.P.E.P. § 2142.

Claims 9 and 17 stand rejected as obvious over Blumberg in view of Hansen. Claim 11 stands rejected as obvious over Blumberg in view of www.kinkos.com and further in view of

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Internet Printing Solutions. Claim 19 stands rejected over Blumberg in view of www.kinkos.com. Applicants respectfully traverse the rejections.

A. Claims 9, 11, 17 and 19

Each of claims 9, 11, 17 and 19 depends from an independent claim already shown above to be allowable. Thus, these claims are also in condition for allowance and the rejection under 35 U.S.C. §103 should be withdrawn.

B. Claims 9 and 17.

Furthermore, Blumberg and Hansen fail to render claims 9 and 17 obvious. Each of claims 9 and 17 include a means for changing, by a user, status information on a copy reproduction request in the database. While the Examiner admits that this limitation is not found in Blumberg, the Examiner argues such a limitation is taught by Hansen and that one of ordinary skill in the art would be motivated to combine the two references to arrive at Applicants' claimed invention as found in claims 9 and 17.

Hansen is directed to a system and method for visual representation of pages in a production printing workflow. Hansen is cited for its disclosure that job tickets can be used with the print orders in the workflow and that those job tickets can be deleted, thus resulting in a change of status for the print job. Office Action at page 5. However, this is not the same as Applicants' claimed invention that provides a means for the user to change the status.

The ability to delete or move a ticket is described in Hansen as associated with the ticket menu, one of several available menus on the graphic user interface display. Hansen at Col. 15, lines 11-20. The graphic user interface for use with these menus is implemented by a desktop, which is part of the job preparation station. Hansen at Col. 13, lines 20-26. As shown in Fig. 1a of Hansen, the job preparation station (116) is specifically shown as part of the print shop side of

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the workflow, not the print shop client side of the workflow. As a result, the "user" described in Hansen is someone associated with the print shop itself, which is not the same user in Applicants' claimed invention where the user is differentiated from the copy reproduction service provider.

Thus, Hansen only teaches providing a way for the print shop to change the status information of the job, not the user, which as found in Applicants' claimed invention, is different from the copy reproduction service provider. Therefore, even if one of ordinary skill in the art did combine Blumberg with Hansen and further ignored Blumberg's teachings with respect to a copy reproduction request database, one would still not arrive at Applicants' claimed invention as found in claims 9 and 17.

C. Claim 11.

Blumberg and www.kinkos.com at the very least fail to render claim 11 obvious. The Examiner admits that Blumberg fails to teach a copy reproduction order form, a wide format order form, and a CD-ROM reproduction order form. The Examiner cites www.kinkos.com and Internet Printing Solutions as together teaching this additional limitation. While www.kinkos.com shows a web order form, it does not show either a wide-format order form or a CD-ROM order form. The Examiner has merely asserted that because the www.kinkos.com order form contains a comment box, that a wide format order form is disclosed because special instructions could be provided with respect to a wide format order. This argument is untenable.

In order to maintain the rejection, the Examiner must provide a reference that contains some teaching or suggestion of the claim limitation, i.e. a wide format order form. All the Examiner has provided is an empty text box from www.kinkos.com. The absence of any teaching of Applicant's claimed invention coupled only with a text box with no apparent field

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restrictions in which someone might possibly request a wide format reproduction simply cannot be said to meet the legal requirements to make out a *prima facie* case of obviousness.

Similarly, Internet Printing Solutions merely mentions in passing that a CD-ROM is one potential medium on which a digital reproduction might be made for digital audio and video information. It does not follow that because a CD-ROM is disclosed as a possible output format when making digital audio and video reproductions that a copy reproduction request would include a specific CD-ROM reproduction order form, much less a CD-ROM production order form in combination with a copy reproduction order form and a wide format order form.

Therefore, a *prima facie* case of obviousness has not been presented with respect to any of claims 9, 11, 17 or 19 and the rejections should be withdrawn.

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CONCLUSION

In view of the above, Applicants respectfully request reconsideration of the Application and withdrawal of the outstanding rejections. Applicants respectfully submit that claims 1-20 are not anticipated nor rendered obvious by Blumberg, Hansen, www.kinkos.com, Internet Printing Solutions or their combination and thus, are in condition for allowance. As the claims are not anticipated by, nor rendered obvious in view of, the applied art, Applicants request allowance of claims 1-20 in a timely manner. If the Examiner believes that prosecution of this Application could be expedited by a telephone conference, the Examiner is encouraged to contact the Applicants' undersigned representative.


This Response has been filed within three months of the mailing date of the Office Action and it is believed that no fees are due with the filing of this paper. In the event that Applicants are mistaken in their calculations, the Commissioner is authorized to deduct any fees determined by the Patent Office to be due from the undersigned's Deposit Account No. 50-1059.

Date: January 20, 2005

Respectfully submitted,

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By:

A handwritten signature in black ink, appearing to read "Shawn K. Leppo", with a horizontal line drawn underneath it.

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